

## **REMARKS**

Claims 1-37 are pending in the application. Claims 1, 16, and 34 are the only independent claims.

### ***Drawings***

The Examiner has required new corrected drawings in compliance with 37 C.F.R. § 1.121(d) because the original filed drawings are deemed to be informal.

In response to the to the objection to the drawings under 37 C.F.R. § 1.121(d), applicant submits herewith five (5) formal drawing sheets containing Figures 1 through 16, to be substituted for the informal sheets currently on file in the application. A separate transmittal letter for the substitute drawings is enclosed herewith.

### ***Claims Rejections - 35 U.S.C. § 103***

Claims 1, 12-14, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,656,735 to Okada et al. in view of U.S. Patent No. 5,383,883 to Wilk et al.

Claims 15 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,656,735 to Okada et al. in view of U.S. Patent No. 5,383,883 to Wilk et al. and further in view of U.S. Patent No. 6,024,741 to Williamson et al.

The Examiner has allowed claims 34-37 and has indicated that claims 2-11, 17-30, 32, and 33 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicants respectfully traverse the rejection of claims 1, 12-16 and 31 under 35 U.S.C. § 103(a). Applicants request that the Examiner kindly reconsider the rejection in view of the following observations regarding the prior art and applicants' invention.

**Claim 1** As set forth in claim 1, a surgical device comprises (a) a forceps member having at least one prong formed as an electrode, (b) at least one electrical connector on said forceps member for operatively connecting the prong to an electrical power source, and (c) a mechanical connector attached to said forceps member for removably fastening said forceps member to a housing of an ultrasonic probe.

Okada et al. ("Okada"), the principal reference relied on by the Examiner, discloses an ultrasound treatment device including an ultrasonic probe (8) and a holding member (1) in the form of a jaw pivotally disposed near a distal end of the probe for performing a clamping or holding function in cooperation with the distal end (7) of the probe. The Okada reference specifically contemplates that electrical current may be conducted through the ultrasonic probe (8) and *teaches away from conducting electrical current through the holding jaw* (1) for reasons explained hereinafter.

The teachings of Okada would clearly convince one of ordinary skill in the art *not* to provide the holding jaws with an electrode function. Okada specifically teaches that where electrical current is conducted through the probe the holding jaws (1) *must* be made of an insulating material:

The holding member 1 and screw 2 are molded *using an insulating material* such as a resin in case consideration is, as mentioned later, taken into a treatment to be conducted by feeding a high-frequency current. *In any other case*, the holding member 1 and screw 2 *may be molded using a metal* or the like. (Emphasis added.) (Col. 10, lines 8-13.)

When a treatment using a high-frequency current is required, a high-frequency current is supplied from a high-frequency power supply that is not shown to the handpiece 32, and then fed from the handpiece 32 to the distal member 7 via the ultrasonic transducers 50.

Thus, a high-frequency current is fed to a living tissue through the distal member 7. Similarly to the aforesaid procedure using ultrasonic vibrations, the living tissue can be ablated, incised, or coagulated by the high-frequency current. *At this time, as mentioned above, the channels of the probe 8 and of the forceps unit 58 are isolated from each other perfectly. Furthermore, the holding member 1 is molded with an insulating member. A treatment by a high-frequency current can therefore be achieved safely and efficiently without a high-frequency current leakage.* (Emphasis added.) (Col. 14, line 61, through col. 15. line 8.)

In view of these teachings of Okada, one of ordinary skill in the art would not even consider conducting current through the holding jaw (1) rather than the ultrasonic probe. In such a proposed alternative design, the above-quoted teachings of Okada would require that the probe (8) be made of a polymer or other insulating material to prevent high frequency current leakage. However, an ultrasonic probe must be made of a metal. No other material has the requisite properties of strength and resilience. Ultrasonic probes are commonly made of a super-strong metal such as titanium.

Applicants also respectfully traverse the Examiner's reliance on the Wilk reference in rejecting claim 1 and other claims of the present application. Applicants' claim 1 recites that the forceps prong is formed as an electrode. In the Wilk reference, there is no forceps prong or jaw member formed as an electrode. The jaws are members provided with internal electrical resistors that receive a current for heating the jaws and a clip contained therebetween. The jaws themselves do not serve as electrodes. While Wilk might suggest providing the holding jaw (1) of Okada with a resistor for heating the jaw, the jaw must remain insulated pursuant to the teachings of both Okada. Moreover,

Wilk would not suggest to one of ordinary skill in the art that the holding jaw (1) of Okada be formed as an electrode.

Claim 16 is believed to distinguish over the cited references for the reasons discussed above with reference to claim 1.

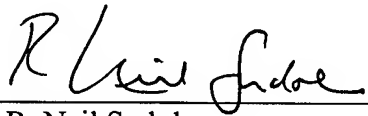
***Conclusion***

For the foregoing reasons, independent claims 1 and 16, as well as the claims dependent therefrom, are deemed to be in condition for allowance. An early Notice passing the application to issue is earnestly solicited.

Should the Examiner believe that direct contact with applicant's attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

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